



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,368	03/22/2004	John P. Lunsford	80121-08961	3955

758 7590 02/09/2006

FENWICK & WEST LLP
SILICON VALLEY CENTER
801 CALIFORNIA STREET
MOUNTAIN VIEW, CA 94041

EXAMINER

STOKES, CANDICE CAPRI

ART UNIT	PAPER NUMBER
----------	--------------

3732

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/807,368	Applicant(s) LUNSFORD ET AL.	
	Examiner Candice C. Stokes	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12, 17, 18 and 20 is/are rejected.
- 7) ☒ Claim(s) 10, 11, 13-16 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 5, line 2 the term “the lumen” is recited. It is unclear which lumen is being referred to, the lumen of the retractor or the auxiliary lumen. For examination purposes, “the lumen” is taken to be the lumen of the retractor.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilk (USPN 5,273,026). Wilk discloses a surgical apparatus comprising a cannula 12 having a lumen extending therein between proximal and distal ends; a retractor 14 disposed to slide within the lumen to extend a distal end thereof beyond the distal end of the cannula 12. Specifically Wilk discloses “a retractor for use in laparoscopic surgery comprises a substantially rigid tubular outer member 12 and a retractor member 14 partially inserted in tubular member 12 for slidable

Art Unit: 3732

motion in an axial or longitudinal direction relative thereto” (column 3, lines 43-47). Wilk also discloses an angling device 28b near the distal end of the retractor 14 and extending within the cannula 12 toward the proximal end thereof. The remaining portion of the claim “for selectively deflecting....” is a recitation of the intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. Since the prior art structure is capable of performing the intended use, then it meets the claim. As to claim 2, Wilk discloses a tension member (see column 4, lines 21-23) extending within the cannula 12 from attachment to the retractor 14 beyond the distal end of the cannula 12, to a handle 38 disposed near the proximal end of the cannula 12. The portion of the claim that recites “for selectively exerting tension...” is a recitation of the intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. Since the prior art structure is capable of performing the intended use, then it meets the claim. Regarding claim 3, the auxiliary lumen through the tension member is the lumen of retractor 14. As to claim 4, it is inherent that the distal portion of the retractor 14 is resiliently flexible since tension members or angling devices 28a,28b bend. Regarding claim 5, the resiliently flexible support (the part of 28a,28b that bends) is slidably disposed within the lumen and includes a cradle 32 attached at a distal end thereof. With respect to claim 6, the cradle 32 is disposed to engage a vessel structure (see column 5, lines 23-26). As to claims 7-9, Wilk discloses “during a laparoscopic surgical procedure” “the operating surgeon or an assistant pushes the retractor member 14 in a distal direction through tubular member 12 so that distal end portion 16 is bent against a camming surface 18 and out through opening 22,

Art Unit: 3732

whereby retractor member 14 is reconfigured from the linear configuration of FIG. 1 to the L-shaped configuration of FIG. 2” (column 4, lines 55&62-68) Also it is disclosed that “actuator member or handle 38 may take the form of one or two rotary knobs or cranks for manually exerting tension on tension members 28a,28b to bend cradle 32 into hook shape 34 or 36” (column 4, lines 25-29). Also with respect to claims 7-9,12, and 17-18 “the outwardly projecting terminal part 20 of retractor member 14 is brought into engagement with a selected internal body organ of a patient. A force is exerted on the retractor member 14 and/or tubular member 12 to push or pull the selected internal body organ and thereby effectuate a shifting thereof to facilitate a laparoscopic operation” (column 5, lines 5-12). With respect to claim 20, arm 26 supports a vessel cradle 32 initially when closing lateral opening 22.

Allowable Subject Matter

Claims 10-11,13-16, and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Candice C. Stokes whose telephone number is (571) 272-4714.

The examiner can normally be reached on 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Candice C. Stokes


Cary E. O'Connor
Primary Examiner